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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,513	05/05/2001	Dennis G. Earnshaw	1234-004/MMM	8685
33717	7590	11/03/2006	EXAMINER	
GREENBERG TRAURIG LLP 2450 COLORADO AVENUE, SUITE 400E SANTA MONICA, CA 90404			VIG, NARESH	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/849,513

**Applicant(s)**

EARNSHAW, DENNIS G.

**Examiner**

Naresh Vig

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 14-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 14-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This is in reference to response received on 06 September 2006. Claims 1-10 and 14-24 are pending for examination.

#### ***Response to Arguments***

Applicant is arguing amended claims. Applicant's arguments and concerns with respect to pending claims 1 – 10 and 14 – 24 have been considered and answered in response to the claims.

In response to applicant's argument that in cited reference document to be sent is created by a user and the user handwrites or types the email addresses on a form (the user fills the form).

However, applicant is arguing a limitation of automatic generation of fax cover-sheet recipient's email address without need for user to creating the fax cover sheet which is not positively claimed by the applicant.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 7 – 10, 14, 18 – 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henry US Patent 6,424,426 in view of Akimoto US Patent 6,775,711.

Regarding claims 1 and 14, Henry teaches an electronic business transaction service method and software in a computer readable medium for conducting a business transaction over a computer network. Henry teaches:

creating on a first computer an electronic business transaction document to be directed to a plurality of recipient parties to a business transaction [Fig. 1, 5, 6 and disclosure associated with Fig. 1, 5, 6], the electronic business transaction document being created by a business management software program (applicant is claiming using a computer system to generate a business document as their invention. It is old and know that business have used documents using a computer system which can be sent to a recipient from a sender as an attachment to an email, or, may be also as a cut-and-past as a part of an email, also, for example, fax forms generated using a computer

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system), the electronic business transaction document including a preferred communication format indicator for each of the plurality of recipient parties of the business transaction [Fig. 6], the electronic document being directed to at least one recipient party in a computer communication format [Fig. 6 shows confirmation page with 2 recipients receiving via email] and to at least one other recipient party in a non-computer communication format [Fig. 6 shows on the same confirmation sheet third recipient receiving information on their fax];

transmitting the electronic business transaction document over the computer network to a network-connected transaction service server computer [Fig. 5 and disclosure associated with Fig. 5]; and

Henry does not explicitly teach determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction. However, Akimoto teaches determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction, the preferred communication format being determined by an electronic business management software residing at the transaction service server computer that interprets the preferred communication format indicator of each of the plurality of recipient parties of the business transaction [Akimoto, Fig. 8 and disclosure associated with Fig. 8];

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Henry as taught by Akimoto to make it possible to add a plurality of new functions with minimal changes to the existing system.

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Henry in view of Akimoto teaches if the transaction service server computer determines that the preferred communication format of a recipient party is a computer communicating format, sending the electronic business transaction document from the transaction service server computer to a first recipient party using a computer communication format [Akimoto, Fig. 8 and disclosure associated with Fig. 8]; and

if the transaction service server computer determines that the preferred communication format of a recipient party is a non-computer communicating format, sending the electronic business transaction document from the transaction service server computer to a second recipient party using a user preferred non-computer communication format, wherein the user preferred non-computer communication format can be telephonic facsimile or regular mail [Akimoto, Fig. 8 and disclosure associated with Fig. 8];

Regarding claim 19, Henry teaches electronic business transaction service method for conducting a business transaction over a computer network. Henry teaches:

receiving from a client computer an electronic business transaction document that is compatible with a business management software program [Fig. 5 and disclosure associated with Fig. 5], the electronic business transaction document being directed in one or more communication formats to plural recipient parties to a business transaction [Fig. 1, 5, 6 and disclosure associated with Fig. 1, 5, 6], the electronic business transaction document being created by a business management software program in the client computer (e.g. email) the electronic business transaction document including

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a preferred communication format indicator for each of the plurality of recipient parties of the business transaction [Fig. 6], wherein the electronic business transaction document is received by a transaction service server computer communicating with the client computer through a computer network [Fig. 5 and disclosure associated with Fig. 5];

Henry does not explicitly teach determining at the transaction services service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction. However, Akimoto teaches determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction, the preferred communication format being determined by an electronic business management software residing at the transaction service server computer that interprets the preferred communication format indicator of each of the plurality of recipient parties of the business transaction [Akimoto, Fig. 8 and disclosure associated with Fig. 8];

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Henry as taught by Akimoto to make it possible to add a plurality of new functions with minimal changes to the existing system.

Henry in view of Akimoto teaches that if software residing at the transaction service server computer that interprets the preferred communication format indicator of each of the plurality of recipient parties of the business transaction, and

if the transaction service server computer determines that the preferred business transaction document communication format of a party is a computer communication

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format, sending the electronic business transaction document from the transaction service server computer to a first recipient party using a computer communication format [Akimoto, Fig. 8 and disclosure associated with Fig. 8]; and

if the transaction service computer determines that the preferred business transaction document communication format of a party is a non-computer communication format, sending the electronic business transaction document from the transaction service server computer to a second recipient party using a non-computer communication format [Akimoto, Fig. 8 and disclosure associated with Fig. 8].

Regarding claims 2 and 20, Henry in view of Akimoto teaches preferred communication format includes telephonic facsimile.

Regarding claim 7, as responded to earlier, Henry in view of Akimoto teaches business management software program is capable of automatically extracting and populating information from the electronic business transaction document, transmitting access to the business management software component with the electronic business transaction document in the computer format to the at least one recipient party, if it is determined that the at least one recipient party is not capable of viewing the electronic business transaction document, the business management software component not being capable of automatically populating and extracting information from electronic business transaction documents (obvious to one of ordinary skill in the art at the time the invention was made that if a user does not have capability for handling electronic



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file, they will not be able to view the electronic file, for example, a user with computer environment which does not have graphic capability will not be able to recreate graphics to be displayed on their computer).

Regarding claims 8 – 9, Henry in view of Akimoto teaches capability wherein the electronic business transaction document can include a markup language or Extensible Markup Language as content in the computer file.

Regarding claims 10 and 18, as responded to earlier, Henry in view of Akimoto teaches capability wherein business transaction can be related to a construction project.

Regarding claim 23, Henry in view of Akimoto teaches capability for manually changing the preferred communication format automatically associated with the recipient party prior to sending the electronic business transaction document to a recipient party [Akimoto, Fig. 8 and disclosure associated with Fig. 8].

Claims 3 - 6, 15 – 17 and 21 – 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henry US Patent 6,424,426 in view of Akimoto US Patent 6,775,711 and further in view of NetGram.com hereinafter known as NetGram.

Regarding claim 3, Henry in view of Akimoto does not explicitly teach the preferred communication format includes regular mail, a printed copy of the electronic business transaction document is mailed to a recipient party. However, Henry in view of Akimoto teaches plurality of tags can be used to indicate different type of delivery means for a recipient [Akimoto, Fig. 7, 8 and disclosure associated with fig. 7, 8]. Also, it is known at the time of invention to one of ordinary skill in the art that businesses have mailed printed copy of business transaction document to recipient party. However, NetGram teaches services for sending sender's electronic document via postal mail to recipient of the document [NetGram page 11 – 13]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Henry in view of Akimoto as taught by NetGram to allow senders outsource mailing of their business documents.

Regarding claims 4, 15 and 21, Henry in view of Akimoto does not explicitly teach storing in an electronic address book address information for each party and the preferred communication format indicator for each of the plurality of recipient parties of the business transaction indicating the one of the computer and non-computer communication formats in which to transmit communications to the party. However, NetGram teaches address book address information for each party and the preferred communication format indicator for each of the plurality of recipient parties of the business transaction [NetGram page 4].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Henry in view of Akimoto and use address book of NetGram to store preferred communication format indicator for each recipient parties to allow the senders to reuse previously stored addresses in the electronic address book. For example, email services like AOL which teaches address book for their subscribers.

Regarding claims 5, 16 and 22, Henry in view of Akimoto and NetGram teaches adding a recipient party to the electronic business transaction document automatically associates with the recipient party the preferred communication format indicator.

Regarding claims 6, 17 and 24, Henry in view of Akimoto does not explicitly teach charging a fee for each recipient party to which the electronic business transaction document is sent from the transaction service server computer. However, NetGram teaches to charge fee to sender [NetGram 9].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Henry in view of Akimoto as taught by NetGram and start charging fee to recover operational costs.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

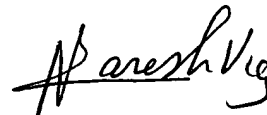
Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Naresh Vig", with a stylized flourish at the end.

Naresh Vig  
Examiner  
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